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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,369	06/05/2001	Kengo Ochi	2309/OJ434	7467

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EXAMINER

SMITH, KIMBERLY S

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/875,369

Applicant(s)

OCHI ET AL.

Examiner

Kimberly S Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04/28/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-9 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant has submitted an Information Disclosure Statement with references showing that the term “alpha-starch” is a recognized term within the art. However, the basis for 35 U.S.C. 112 states that “The *specification* shall contain a written description of the invention...in such *full, clear, concise and exact terms...*”. The references cited in Paper number 14 show that alpha-starch can relate to a physically modified starch (US 6,515,054), a binder (US 6,417,175 and 6,288,059), a film base not necessarily soluble in water (US 6,416,503), a starch derivative (US 6,392,082 and US 6,391,903), a starch/polymer compound having a sugar skeleton (US 6,388,077), a starch derivative (US 6,326,332), a physically modified starch (6,277,869) and a gelatinized starch obtained from starch containing raw materials (US 5,571,545). The citing of these references does not provide a basis for “alpha starch” being defined in exact terms in the specification as required by 35 USC 112. Is the alpha starch a binder, a sugar skeleton, a starch derivative? The specification as submitted does not provide the basis for one having ordinary skill in the art to ascertain what is considered generic and equivalents of the term alpha starch. It is noted that the cited references all include the term “alpha starch” in a list of compounds to be considered

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equivalents of a generic term and is not use singularly as a known and defined term. Through the prosecution history of the instant application, the Applicant has stated that in the invention as claimed, the term "alpha starch" is considered to be a modified, pre-gelatinized starch. While the prosecution history at present does not obviate the 35 USC 112 1<sup>st</sup> paragraph, the following art related rejection is based upon the term "alpha starch" constituting a modified, pre-gelatinized starch.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: replace "comprises" in line 1 with - -comprising- -. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasahara, JP 11-032608 in view of McPherson et al., US Patent 6,405,677 (McPherson).

Sasahara discloses an animal excretion-treating material comprising particles having a core layer of fibers and a skin layer containing starch and fibers (paragraph 0010). However, Sasahara does not positively disclose the use of alpha-starches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use alpha-starch, since it has been held to be within the general skill of a worker in the art to select a known material (reference McPherson, column 4, lines 54-56 stating that prior art litters employ modified, pre-gelatinized starches) on the basis of its suitability for the intended use as a matter of obvious design choice.

Sasahara further discloses the fibers in the core layer and skin layer are those of pulp; wherein the bulk density falls between 0.1 and 0.5 (paragraph 0026); wherein the particle has a diameter between 2 and 20 mm (paragraph 0009).

Regarding claims 2-4, Sasahara discloses the invention substantially as claimed. However, Sasahara does not positively disclose that the skin layer fibers have a length between .02 to 1 mm, that the particle size of the starch in the skin layer is at most .25mm or that the skin layer has a starch to fiber ratio between 20 to 80 and 80 to 20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to find the optimal values of the fiber length and the particle size, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

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7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasahara as modified as applied to claim 1 above, and further in view of Chikazawa, US Patent 5,209,185.

Sasahara as modified discloses the invention substantially as claimed. However, Sasahara does not disclose the starch being tapioca. Chikazawa teaches within the same field of endeavor the use of tapioca as a starch in an artificial litter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use tapioca as the starch as taught by Sasahara as modified, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

### *Conclusion*

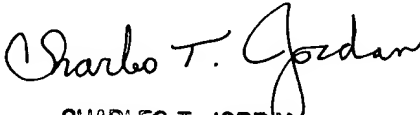
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S Smith whose telephone number is 703-308-8515.

The examiner can normally be reached on Monday thru Friday 10:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles T Jordan can be reached on 703-306-4159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

kss  
May 9, 2003

  
CHARLES T. JORDAN  
SUPERVISOR, PATENT EXAMINER  
TECHNOLOGY CENTER 3600